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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/530,907	06/30/2000	RUDI WILFRIED JAN PAUWELS	07619.0006	4853

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PHILIP S. JOHNSON  
JOHNSON & JOHNSON  
ONE JOHNSON & JOHNSON PLAZA  
NEW BRUNSWICK, NJ 08933-7003

EXAMINER

SHIBUYA, MARK LANCE

ART UNIT PAPER NUMBER

1639

DATE MAILED: 10/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

**Application No.**

09/530,907

**Applicant(s)**

PAUWELS ET AL.

**Examiner**

Mark L. Shibuya

**Art Unit**

1639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24, 26-36 and 38-40 is/are pending in the application.
- 4a) Of the above claim(s) 8, 11-16, 20-23 and 38-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5-7, 9, 10, 17-19, 24 and 26-36 is/are rejected.
- 7) ☒ Claim(s) 2-4, 27 and 28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date. _____  | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. Claims 1-24, 26-36, 38-40 are pending. Claims 25, 37 and 41-68 are canceled.

Claims 25 and 41-68 were canceled in the Reply to the previous Office action, filed 7/26/2004 (stating, at p. 7, "claim 25 and claims 45-68 have been canceled"; however the listing of the claims shows that claims 25 and 41-68 were canceled thereby).

Claims 2-4, 27 and 28 are objected to. Claims 8, 11-16, 20-23, 38-40 remain withdrawn from consideration, there being no allowable generic claim. Claims 1-7, 9, 10, 17-19, 24, and 26-36 are examined.

### ***Election/Restrictions***

2. This application contains claims 8, 11-16, 20-23, 38-40 drawn to an invention nonelected with traverse in Replies to the Requirement for Restriction/Election, filed 6/20/2002, 9/20/2002, and 3/19/2003. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Priority***

3. This application is the national stage entry of PCT/IB98/01399, filed 9/8/1998.

### ***Claim Objections***

4. Claims 2-4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 27 and 28 are objected to for depending from canceled claim 25.

***Claim Rejections - 35 USC § 112, Second Paragraph***

*Withdrawn Claim Rejections*

5. The rejections of claims 1, 26 and 31 are withdrawn in view of applicant's amendments, filed 7/26/2004.

*Maintained Claim Rejections*

6. Applicant's argues that the amendments to claims 6, 17-19, 27, and 28, filed 7/26/2004, overcome the rejections of said claims, under 35 U.S.C. 112, second paragraph; this is not persuasive.

*Response to Amendments and Arguments*

The rejection of claim 6 is maintained because it is unclear how the material allows for spontaneous release of the analytes. The rejections of claims 17-19 are maintained because the amendments to claim 17 are not related to and do not clarify how the elected support of "film or tape" coats a solid support or coats a compact disc (claim 19). The rejection of claims 27 and 28 under 35 U.S.C. 112, second paragraph are maintained because it is still unclear how the "film or tape" can be provided in individually identifiable containers or different compartments.

*New Claim Rejections*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 6, 7, 17-19, 26-28, and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the

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subject matter which applicant regards as the invention. These rejections are necessitated by applicant's amendments to the claims, filed 7/26/2004.

Claim 6, recites the language "wherein the analytes when applied to the solid support are spontaneously released", which renders the claim vague and indefinite, because it is unclear as to from what the analytes are released. This rejection was necessitated by applicant's amendments to the claims, filed 7/26/2004. Likewise, claim 7, recites the language "wherein the analytes when applied to the solid support are controlled released", which renders the claim vague and indefinite, because it is unclear as to from what the analytes are released.

Claim 17 recites the language "the solid support is coated with a a layer with molecules", said repeated "a" rendering the claim grammatically incorrect. Likewise, claim 26 recites the language "each analyte is applied to a a rod shape", said repeated "a" rendering the claim grammatically incorrect.

Claim 18 recites the language "the solid support is [itself] an information carrier", which renders the claim vague and indefinite because the meaning of "[itself]" is unclear.

Claims 27 and 28 recite the language "[a] method according to claim 25" and "[a] method according to claim 27", respectively, which renders the claims vague and indefinite because claim 25 has been canceled.

Regarding claim 31, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

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See MPEP § 2173.05(d). Furthermore, claim 31 recites the term "drying liquefies", which renders the claim vague and indefinite because the term does not make sense.

***Claim Rejections - 35 USC § 112***

8. The rejection of claim 31 under 35 U.S.C. § 112, first paragraph, for lacking written description, is withdrawn in view of applicant's amendments and arguments.

***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 1, 5-7, 9, 10, 17, 24, 26, 29, 30, and 32-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Lerner et al. (US 5,601,992). This rejection is maintained for the reasons of record as set forth in the previous Office action, mailed 3/24/2004.

**Response to Arguments**

Applicant argues that the reference of Lerner does not teach or suggest all elements of the rejected claims. Applicant argues that the method of Lerner differs from the claimed invention because the claimed invention uses "analytes", not beads. Applicant argues that Lerner et al. discloses using beads, not analytes. Applicant further argues that Lerner fails to inherently anticipate the claimed invention, and cites to MPEP 2112, for the proposition that missing descriptive matter must be necessarily present in the reference. Reply to the previous Office action, at p. 10.

Applicant's arguments filed 7/26/2004 have been fully considered but they are not persuasive. Firstly, the claimed invention uses analytes that are beads, e.g., as in

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instant claim 29, which recites: "A method according to Claim 1 wherein the *analytes* are selected from chemical compounds, antigens, antibodies, DNA-probes, cells and *beads* and liposomes carrying an analyte of interest [emphasis added]." Thus the claimed invention uses beads. Secondly, Lerner, at col. 2, lines 16-18, for example, discloses oligomeric molecules, which interact with a target, and that, absent evidence to the contrary, are "analytes" of the claimed invention. Thus, Lerner et al. discloses using analytes. Thirdly, Lerner at col. 3, lines 8-12, for example, teaches "[t]he method includes applying a plurality of beads having multiple copies of the oligomeric molecules associated therewith, to a substrate that is constructed and arranged to permit only localized diffusion of molecules." Because Lerner *expressly* teaches all of the elements of the inventions of claims, as demonstrated above, applicant's argument that Lerner fails to inherently anticipate the claimed invention, is inapposite.

It is noted that amended claim 17 now recites the limitation that the solid support is coated with a "layer with molecules", which reads on practically any solid support. Also, amended claim 31 is drawn now to methods comprising solvents that include "natural and synthetic polymers", which reads on proteins, nucleic acids, etc., that are naturally found in culture media, as taught in col. 5, line 55-col. 26, line 52, of Lerner.

### **Conclusion**

10. Claims 1, 5-7, 9, 10, 17-19, 24, 26-36 are rejected. Claims 2-4, 27 and 28 are objected to. Claims 2-4 are free of the prior art.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark L. Shibuya whose telephone number is (571) 272-0806. The examiner can normally be reached on M-F, 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571) 272-0811. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
PADMASHRI PONNALURI  
PRIMARY EXAMINER

Mark L. Shibuya  
Examiner  
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